

Application No.: 10/090,591

Docket No.: JCLA8596-R

### **REMARKS**

#### **Present Status of the Application**

The Office Action rejected claims 1-2, 4-7, and 9-34 under 35 U.S.C. 102(e), as being anticipated by Takano (U.S. Application Publication 2001/0041072, hereinafter "Takano").

Furthermore, claims 1, 6, 19 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action on page 2 alleged that there is insufficient antecedent basis for the limitation "the received digital data" and "the stored digital data" recited in claims 1, 6, 19, 25, 30, 31, 32, and 33.

After traversing of the aforementioned claim rejections and amending of the claims, claims 1-2, 4-7 and 9-34 remain pending in the present application, and reconsideration of those claims is respectfully requested.

#### **Summary of Applicant's Invention**

The Applicant's invention is directed to an information storage method and the apparatus for performing the method. In the present invention, a server receives a storage request of an image data input by the input device as well as the input device location information. The server receives the image data and stores the image data into storage device. After that, the server transmits the completed information to the input device, wherein the completed information

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includes the storage location information, the access information for retrieving the image data from the storage device, the advertising information etc. More specifically, the access information further comprises a password for an authentication process in order to legally access the stored image data from the storage device.

### **Discussion of Office Action Rejections**

*The Office Action rejected claims 1-2, 4-7, and 9-34 under 35 U.S.C. 102(e), as being anticipated by Takano (U.S. 2001/0041072, hereafter Takano).*

Applicants respectfully traverse the rejection for at least the reasons set forth below.

It is well established that anticipation under 35 U.S.C. 102 requires each and every elements of the rejected claims must be disclosed exactly by a single prior art reference.

The independent claims 1, 6, 25, 30, 31 and 33 are allowable for at least the reason that Takano fails to teach or disclose each and every features of the amended independent claims 1, 6, 25, 30, 31 and 33. The amended claims 1, 6, 25, 30, 31 and 33 recite respectively:

Claim 1. An information storage method, comprising:  
receiving digital data input from an input device through a communication  
line;  
storing a received digital data; and  
transmitting access information for accessing a **storage location of the  
stored digital data itself** and a print instruction for printing the access information

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to an external device having a print function through the communication line, wherein the access information includes **a password for an authentication process in order to access the stored digital data, and the password is managed by a data storage device.**

Claim 6. An information storage method, comprising:

receiving digital data input from an input device through a communication line;

storing a received digital data; and

transmitting access information for accessing **a storage location of the stored digital data itself** and distinguishing information for identifying the digital data to an external device having a print function through the communication line, wherein the access information includes **a password for an authentication process in order to access the stored digital data, and the password is managed by a data storage device..**

Claim 25. A digital data processing method, comprising

inputting digital data;

transmitting the input digital data to an external device that stores the digital data through a communication line; and

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printing access information for accessing a **storage location of the digital data itself** on a print medium, the digital data being transmitted to and stored in the external device, wherein the access information includes a **password for an authentication process in order to access the stored digital data, and the password is managed by a data storage device.**

Claim 30. An information storage apparatus, comprising

a receiving device that receives digital data input from an input device through a communication line;

a storing device that stores the digital data received by the receiving device;

and

a transmitting device that transmits access information for accessing a **storage location that stores the digital data itself** and a print instruction of the access information to an external device having a print function through the communication line, wherein the access information includes a **password for an authentication process in order to access the stored digital data, and the password is managed by a data storage device.**

Claim 31. An information storage apparatus, comprising:

a receiving device that receives digital data input from an input device through a communication line;

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a storing device that stores a received digital data; and

a transmitting device that transmits access information for accessing a **storage location of the stored digital data itself** and distinguishing information for identifying the digital data to an external device having a print function through the communication line, wherein the access information includes **a password for an authentication process in order to access the stored digital data, and the password is managed by a data storage device..**

Claim 33. A digital data processing apparatus, comprising

an inputting device that inputs digital data;

a transmitting device that transmits the digital data that is input from the inputting device to an external device that stores the digital data through a communication line; and

a printing device that prints access information for accessing a **storage location of the digital data itself** on a print medium, the digital data being transmitted to and stored in the external device, wherein the access information includes **a password for an authentication process in order to access the stored digital data, and the password is managed by a data storage device.**

As to independent claims 1, 6, 25, 30, 31 and 33, the following claim limitations: “a **password for an authentication process in order to access the stored digital data**” and “the

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**password is managed by a data storage device**” are patentable over Takano based upon the following traversal:

Because of the complexity of the ensuing discussion, some of the traversal is presented in the following Table 1. Table 1 includes a side-by-side comparison and analysis of the **definition** of the patentable claim limitations of **“a password for an authentication process in order to access the stored digital data”** and **“the password is managed by a data storage device”** as well as the inherent definitions of “password” claimed in the independent claims 1, 6, 25, 30, 31 and 33 over the “ID” and “ID Number” in Takano. Please note that the definitions and features for the functions and characteristics of “password” as presented in Table 1 (identified as Item numbers) are the essential and inherent or explicit features that are necessary to fully enable and describe the element “password” without the introduction of any “unnecessary but useful limitations”.

In Table 1, all recited sections are taken from corresponding references; column 1 is for an item number, column 2 is for all recited sections found in the present invention, column 3 is for all recited sections found in Takano, and column 4 includes analysis and comments of the patentable differences identified for each item number.

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Table 1.

Item	"password" in claims 1, 6, 25, 30, 31 and 33 of Present Invention	"ID" and "ID Number" in Takano	Analysis/ Comments
1	As described in paragraph [0095], the data storage device issues <b>password as the authentication information for the access of the image data. Access to the image data is permitted only when the input password is consistent with the issued password.</b>	As described in [0012], the image input apparatus has means for issuing an ID for retrieving digital image data; and an image server comprising means for giving the ID for retrieving digital image data to the digital image data transferred from said image input apparatus...	<b>"password for an authentication process" is <u>patentable over</u> "giving the ID for retrieving..." of Takano.</b>
2	As described and <b><u>fully supported</u></b> in paragraph [0119], the <b>password can be set and managed by the data storage device. (As a result, the added claim limitation in claims 1, 6, 25, 30, 31 and 33: "password is managed by a data storage device" contains no new matter.)</b>	<b><u>No</u></b> teachings of ID being <b><u>managed</u></b> by the data storage device are found in Takano.	<b>"password is managed by a data storage device" is <u>patentable over</u> Takano. A more sophisticated functional role in the management of password is found in the present invention.</b>
3	As described in paragraph [0127], the user (the data acquisition device) that requests the access is requested to input a password of the identification information. <b>When the replied password is obtained, the data storage device refers to the <u>look-up table</u> stored in the memory to obtain a legal password.</b>	<b><u>No</u></b> teachings of a <b><u>look-up table</u></b> in the memory to be referred to or for obtaining a legal password is found in Takano.	The look-up table is not taught in Takano to perform the described functions.

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4	<p>As described in paragraph [0147], <b>to replace (the password)</b>, the data storage device sets an <b>effective storage period</b> for the image data. However,(the password) can be also set together with the effective storage period. Management for the effective storage period has to be executed separately. A timer is set in the data storage device, and the image data can be accessed within the effective storage period based on the timer. <b>Over the effective storage period, it is preferable to execute a predetermined process to <u>erase or move</u> the image data.</b></p>	<p>No teachings are found for the “replacement of the password using an effective storage period” method”.</p> <p>No teachings are found for the <b>erasing or moving</b> of the image data over the effective storage period.</p>	
5	<p><b>No</b> teachings are found for the attachment of password for the retrieval from image input apparatus.</p> <p><b>No</b> teachings are found for “an image input apparatus issuing an ID.”</p>	<p>As described in [0068], to make it possible to use digital image data stored in an image server commonly for an retrieval from an image input apparatus installed in any one of stores, <b>an ID for retrieval is <u>attached</u>.</b></p> <p>If a customer keeps an ID number for retrieving which is issued by an image input apparatus, he can obtain a medium in which image information is recorded at another store. It is <b>desirable that an image input apparatus issues a print of an image list from digital image data together with an ID for retrieval.</b></p>	<p>The actions as described in Takano are well known of easily capable of subjecting a “password” of the present invention to security risks during transmission and final use.</p> <p>Therefore, such actions described in Takano would not be used at all for a “password”</p>



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6	<p><u>No</u> teachings of conveying of password to others orally or by letter, fax, etc... are taught in the present invention.</p> <p>Furthermore, such measures are well known in the art to be highly risky actions that can easily compromise the security of the "password."</p>	<p>As described in paragraph [0071], by <b>conveying</b> the home page address and the <b>ID number for retrieving image data</b> to his friend or his company <b>orally or by a letter, telephone, fax, electronic mail or the like</b>, it becomes possible to peruse digital image data by a computer at the home of his friend or a computer at his office.</p>	
7	<p>The ID as described in Takano is clearly based on each order and order file. Whereas, the "password" as claimed in the present invention is pertaining to the authenticated authorized user instead.</p>	<p>As described in paragraph [0073], a customer, using said image input apparatus, <b>can make an order for digital printing</b>; therefore, he needs not enter an order form at a storefront, while the store acquires an order file, which has been prepared by the customer and has the aforesaid ID for retrieving recorded on it, and the digital image data from an image server, and <b>produces digital prints on the basis of the order file</b>.</p>	<p><b>The "access information includes a password" claim limitation is patentable because of inherently pertaining to the authenticated authorized user instead of being based on each order and order file.</b></p>
8	<p>Same arguments as in Item 6 above.</p>	<p>As described in paragraph [0074], the store, <b>acquires digital image data from the image server on the basis of the ID for retrieving, and produces digital prints on the basis of the order data noted.</b></p>	

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9	<p><b>No</b> teachings are found for the handling of lost passwords as is described for lost ID in Takano. Since it is well known that once a password is compromised or lost, a <b>new one</b> should be generated for its replacement, thereby proper security can then be achieved.</p> <p>Thus there is no method for “coping” with the loss of passwords.</p>	<p>As described in paragraph [0087], <b>to cope with the loss of the ID number in an order which has been treated before, it is appropriate to give such a function that, if only the latest ID number is inputted, a list of the ID numbers which have been obtained before it and the data noting the remaining number of days up to the automatic erasing can be confirmed on the home page, or they are delivered by mail at every predetermined interval.</b></p>	
10	<p>The sending of password via an unsecure regular “electronic mail” is typically strictly prohibited (as is well known in the art).</p> <p>Indeed, this is <b>not</b> taught in the present invention.</p>	<p>As described in paragraph [0092], <b>when an electronic mail address of a person to whom the ID number is to be notified is inputted, an electronic mail carrying the ID number and the home page address with a simple greeting sentence attached is automatically transmitted.</b></p>	

Additional Traversal regarding the patentability of “Password” over “ID Number” in Takano

Takano in paragraph [0065] only teaches of the use of symbols in “ID Number”.

On the other hand, the present invention teaches of using **non-alphanumeric that includes also** punctuations, mathematical operators, logic operators, symbols, etc (common “groupings” based upon commonly available knowledge easily accessible to a person skilled in the art, such as

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described in the previous response to Office Action:

<http://www.microsoft.com/ntserver/techresources/security/password.asp> )

And each of the above “grouping” of non-alphanumerics, such as mathematical operator, punctuations, etc... are **independent and distinct** from the other “groupings”. If the mathematical operator and punctuation “groupings” were hypothetically considered as species; nevertheless, each of the above group **cannot be** categorized as belonging to the **same** genus. They are typically arranged together only for the sake of usage convenience and should not be construed as belonging to the same genus.

As a result, since the punctuation, mathematical operators, and logic operators **with respect to the symbols are not** part of the same genus, the symbol taught in Takano would then clearly **not** be sufficient to anticipate the full scope of the meaning of “password”.

Furthermore, paragraph [0065] in Takano inherently and implicitly teaches of a set of ID number having a “consistent” upper or lower case as shown in the “urq@12” example. On the other hand, “password” can easily contain letters of mixed upper and/or lower cases, such as for example “uRqLW<1:##”.

In Item B) on page 11 of the Office Action, a dictionary definition for the word “password” for drawing parallel to the functions of “ID number” is recited. It should be noted that **intrinsic evidence** as found in the specification **should take precedence over extrinsic evidence – in the form of the dictionary definition** described above; therefore, the dictionary definition should **not be controlling** on the full meaning of “password”.

In support of the above traversal, MPEP 2111.01 describes the following: “[t]he ordinary

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and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, \_\_F.3d\_\_, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*).< *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art."). It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims."

Therefore, the meaning of "password" and "ID number" should not be defined using Webster dictionaries when a person skilled in the art is already fully able to come up with the appropriate and suitable technical definitions based upon the knowledge and technical training of a person skilled in the art within the context of the written description.

As a result, Takano failed to teach "password" for an authentication process to access stored data, as well as failing to teach "password is managed by a data storage device".

Additionally, password clearly defines access to the USER in the present invention, whereas, "ID number" only grants access to the specific set of data only.

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As recited in MPEP 707.07(f): “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.”

Based upon the above recited section from the MPEP, the Applicants contend that the following recited traversal by the Applicants in the previous reponse to Office Action was **not responded to** by the Examiner:

“Furthermore, regarding amended claims 1, 6, 25, 30, 31 and 33, the claim limitations “a storage location of the stored digital data itself” and “a storage location of the digital data itself” are patentable over Takano. It is because the “storage location” in Takano is “...703 denotes a home page address...” as described in paragraph [0084] and FIG. 18 in Takano. As a person skilled in the art would typically appreciate, the “home page address” is **not the same as** “a storage location of the stored digital data itself” or “a storage location of the digital data itself”.”

As a result, the Applicants would like to reiterate the above in the current response.

Based upon the above traversal, claims 1, 6, 25, 30, 31, and 33 are patentable over Takano, and should be allowed.

Furthermore, claims 2, 4-5, 7, 9-18, 26-29, and 34, which depend from independent claims 1, 6, 25, 30 31 and 33, respectively, are also patentable over Takano, at least because of their dependency from an allowable base claim.

Additionally, the Applicants would also like to strengthen the above arguments by adding

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the following:

MPEP 2131.02 recites the following: “[a] genus does not always anticipate a claim to a species within the genus.”

A prior art reference that discloses a genus **still does not inherently disclose all species** within that broad category. See *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1262 (Fed. Cir. 1989) (“Under [defendant’s] theory, a claim to a genus would inherently disclose all species. We find [this] argument **wholly meritless . . .**”) (see MPEP Appendix II: List of Decision Cited).

Regarding claims 19 and 32, the alleged assertion on page 7 of the Office Action that the “digital image data” anticipates the “advertising information” in claims 19 and 32 is **not correct** based on the MPEP 2131.02 and the above case law. This is because the “digital image data” can easily comprise of a multitude of different forms of data. As a result, a claim to the genus of “digital image data” **does not** inherently disclose all of the possible species. Thus, since “advertising information” is only one of the many species which belongs to the much larger genus of “digital image data”, therefore, a genus does not anticipate a species in this instance. As a result, claims 19 and 32 should be allowed.

Claims 20-24, which depend from claim 19, are also patentable over Takano, at least because of their dependency from an allowable base claim. Applicants respectfully assert that these claims are in condition for allowance. Thus, reconsideration and withdrawal of this rejection are respectively requested.

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*Claims 1, 6, 19 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

Figs. 2 and 3, as well as paragraphs [0074] – [0108], of the present invention fully support the claimed invention and subject matter in claims 1, 6, 19 in regards to where the data is being stored, who is transmitting the access information, and where it is transmitted to. The elements and features in claims 1, 6, 19 should **not** be read in a vacuum **but** should be interpreted **in light of** the specification based upon the the following recited sections from the MPEP 2111.01:

As recited in MPEP 2111.01, “(“Claims are not to be read in a vacuum, and limitations therein are to be interpreted **in light of the specification** in giving them their 'broadest **reasonable** interpretation'.” 710 F.2d at 802, 218 USPQ at 292 (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976))”.

Therefore, the above rejections under 35 USC 112, second paragraph, to claims 1, 6, 19 should be withdrawn.

*The Office Action on page 2 stated that there is insufficient antecedent basis for the limitation “the received digital data” and “the stored digital data” recited in claims 1, 6, 19, 25, 30, 31, 32, and 33.*

To overcome the rejections pertaining to insufficient antecedent basis for the limitation “the received digital data” and “the stored digital data” in claims 1, 6, 19, 25, 30, and 31-33, “the received digital data” are appropriately amended to “a received digital data” and “the stored

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digital data" are appropriately amended to "a stored digital data" in each of the corresponding claims above. As a result, the above claim rejections should be withdrawn, and claims 1, 6, 19, 25, and 30-33 should be allowed.

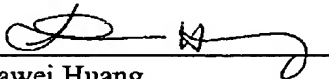
### CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims 1-2, 4-7 and 9-34 are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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